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**REMARKS**

This response is intended as a full and complete response to the non-final Office Action mailed April 25, 2005. In the Office Action, the Examiner notes that claims 1, 3-10, 14, 16, 18, 19, 23-43 and 45-65 are pending and rejected. By this response, Applicants have amended claims 1, 14, 24, 30, 42, 60 and 64, claims 3-10, 16, 18, 19, 23, 25-29, 31-41, 43, 45-63 and 65 continue unamended.

In view of both the amendments presented above and the following discussion, Applicants submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Thus, Applicants believe that all of the pending claims are now in allowable form.

It is to be understood that Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

**PRIORITY**

The priority data for the present case is incorrectly stated on the filing receipt. As stated on page 1 of the specification, the present case is a divisional of 08/160,192 filed 12/2/93. The filing receipt of 10/6/99 incorrectly states that the divisional for this application is 09/160,192. Request for corrected filing receipt has been submitted twice; however, the priority data is still incorrect. A copy of the resubmission filed on 4/5/05 is included in the response. Please correct the priority data in this present application.

**CLAIM OBJECTIONS**

The Examiner objects to claims 42 and 64 because of various informalities.

Applicants have amended claim 42 to correct the typographical error noted by the Examiner. With respect to the Examiner's objection to claim 64 as lacking

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antecedent basis for the limitation "said upgrade decryption module," Applicants respectfully have changed "said" to "an."

In view of the above, Applicants respectfully request at the Examiner's claim objections be withdrawn.

### **REJECTIONS**

#### **35 U.S.C. §103**

##### **Claims 1, 3-10, 14, 16, 18-19, and 23-29**

The Examiner has rejected claims 1, 3-10, 14, 16, 18-19, and 23-29 as being obvious under 35 U.S.C. §103 over Graczyk et al. (U.S. patent no. 5,192,999, issued March 9, 1993, hereinafter "Graczyk") in view of Banker et al. (U.S. patent no. 5,357,276, issued October 18, 1994, hereinafter "Banker"), Palazzi, III et al. (U.S. patent no. 5,327,554, issued July 5, 1994, hereinafter "Palazzi"), and in further view of Granger (U.S. patent no. 5,483,277, issued January 9, 1996). Applicants respectfully traverse the rejections.

Applicants' independent claim 1 (and similarly independent claims 14 and 24) recites:

1. A hardware upgrade for a set top terminal for use with a television program delivery system with menu selection of programs, the set top terminal having a microprocessor and microprocessor instructions for prompting generation of menus, the hardware upgrade comprising:
  - an interface to the set top terminal for receiving and processing subscriber input;
  - a modem connected to the interface capable of communicating with one or more headends, wherein the set top terminal receives television program signals based on the subscriber input; and
  - a microprocessor connected between the interface and the modem,wherein the hardware upgrade is a card insertable into the set top terminal to add a data modulation and demodulation function to the set top terminal such that data may be retrieved and downloads data from the one or more headends and stored in to a local storage. (emphasis added).

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The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Thus, it is impermissible to focus either on the "gist" or "core" of the invention, Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 USPQ 416, 420 (Fed. Cir. 1986) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added).

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (C.C.P.A. 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494 496 (C.C.P.A. 1970), M.P.E.P. 2143.03. Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992); *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In particular, the Graczyk reference discloses a work station 10 formed by a host computer such as an IBM PC-AT compatible system having common communication circuitry within the work station 10 that includes data/fax/voice modem circuit 44, television circuit 46, AM/FM tuner circuit 48, and remote control circuit 50. The telecommunication circuitry 12 provides the user with the ability to send and receive computer data, facsimile transmissions and voice and audio sound over one or more conventional telephone lines. Host computer bus interface 300 provides a communications path between data/fax/voice modem 44 and host computer 24. Consequently, IBM PC-AT compatible industry standard architecture (ISA) interface specifications define the technical requirements for host computer bus interface 300. The data/fax/voice modem circuit 44 is configured to appear to the host computer as a communication circuit. Furthermore, Fig. 41 is just an expansion board containing data/fax/voice modem circuit. Accordingly, the Graczyk reference discloses a computer

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workstation that includes a conventional PC computer having a data/fax/voice modem circuit disposed therein. (see Graczyk, Col. 5, lines 15-25, lines 38-51, lines 62-67, Col. 6, lines 33-48, and lines 62-Col. 7, Line 18, and FIGs. 1 and 2). Graczyk does not disclose, teach or suggest upgrading using an insertable card including a modem for upgrading a set top terminal.

The Banker reference discloses that a set top terminal may include a modem and telephone link to a telephone processor at the head end. (see Banker, Col. 4, Lines 40-50). It is noted that the Banker reference is completely silent with regard to whether the modem is installed in the subscriber terminals as a hardware upgrade to the subscriber terminals. The expansion card 138 is disclosed as a non-volatile memory. Banker does not disclose, teach or suggest upgrading a set top terminal with an insertable card including a modem.

The Palazzi reference discloses "the terminal 17 also features an internal modem 4 so that the terminal 17 may communicate and transmit information to and from the host database via the subscriber's telephone line 1. The modem 4 may carry asynchronous or synchronous data from the subscriber's telephone line 1 and through the DAA, where it is then converted to digitally encoded information for use by the CPU5 (described below). Alternatively, the modem 4 will convert the digital information presented from the CPUS into low frequency analog signals for the DAA to transmit to the host database via the subscriber's telephone line 1" (see Palazzi, Col. 5, Line 63 to Col. 6, Line 6). Nowhere in Palazzi is there any teaching or suggestion that the modem is installed into the subscriber's terminal as a hardware upgrade. Palazzi does not disclose, teach or suggest upgrading a set top terminal with an insertable card including a modem for upgrading a set top terminal.

The Granger reference discloses "for subscribers who want to operate more than two simultaneous channels from among the six, the set-top can be designed in such a way that a switching module can be plugged into a slot at the rear of the set-top converter as shown in Fig. 6. There, a switching module 300 may be purchased separately and plugged into a standard set-top converter 302 having a block diagram as shown in Fig. 7. Also shown in Fig. 7 is a block diagram of the switching module 300 of Fig. 6. (see Granger, Col. 7, Lines 16-24, FIGs. 6 and 7). The switching module

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includes a splitter 330 and a tuner 332. Nowhere in the Granger reference is there any teaching or suggestion of hardware upgrade comprises a modem. Granger does not disclose, teach or suggest an insertable card including a modem for upgrading a set top terminal.

According to MPEP 2143, "teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." The Examiner has improperly combined the teachings of the Graczyk with the three other cited references. Specifically, there is no disclosure, teaching or suggestion of an insertable card including a modem for upgrading a set top terminal. Therefore, the combined references fail to teach or suggest the Applicants' invention as a whole.

Furthermore, the mere fact that a prior art structure, such as a computer system having a modem, could be modified to produce the claimed invention does not make the modification obvious unless the prior art suggested desirability of the modification. None of the cited references, either singly or in combination, teach or suggest "a hardware upgrade comprising a modem connected to the interface capable of communicating with one or more head ends, where the set top terminal receives television program signals based on the subscriber input." The mere closeness of the relationship between the art of personal computers and set top terminals do not make the references combinable. Palazzi is trying to avoid the complexity of the home personal computer (PC) for viewing programs. Granger and Banker are silent on the possibility of using the PC for viewing programs. Graczyk allows for watching TV on the PC but makes no suggestion or teachings that it's method of viewing programs is desirable or even usable in a set top terminal. The references as a whole must show a desirability of the combination. None of the references show the desirability of upgrading with a modem; therefore, there is no motivation to combine.

Moreover, none of the references address and solve the problems that the Applicants' invention solves. In particular, none of the references solve the problem of providing the flexibility to upgrade the set top terminals with a modem to provide data/fax/voice communications on an as-needed basis. Furthermore, the Applicants' invention solves the problem of set top terminals becoming quickly obsolete because

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they do not have the capability to be upgraded, as improvements in technologies allow for additional services to be provided to the subscriber of the set top terminals. Accordingly, the combined references fail to address the problems addressed and solved by the Applicants' invention.

In addition, an upgrade is not any improvement over any previous devices. An upgrade involves additional features and/or reprogramming of existing features of the original set top terminal. Therefore, Graczyk and the other three cited references do not teach, suggest or disclose hardware upgrade with a modem in the set top terminals. Therefore, the combined references fail to teach or suggest the Applicants' invention as a whole.

As such, Applicants submit that claims 1, 14, and 24 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 3-9, 16, 18-19, 23, and 25-29 depend, either directly or indirectly, from independent claims 1, 14, and 24, and recite additional features thereof. As such, and for at least the same reasons discussed above, Applicants submit that these dependent claims also fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, Applicants respectfully request that the rejections be withdrawn.

**Claims 30-42, 45-50, 55, and 58-59**

The Examiner has rejected claims 30-42, 45-50, 55, and 58-59 as being obvious under 35 U.S.C. §103 over Palazzi in view of Banker. Applicants respectfully traverse the rejections.

Applicants' independent claim 30 (and similarly independent claim 42) recites:

30. "An existing television terminal having a microprocessor and microprocessor instructions for prompting generation of menus, the existing television terminal comprising:

a television program receiver;

a hardware upgrade adding a data modulation and demodulation function to the television terminal comprising:

an interface to the television terminal for receiving and processing subscriber input;

a modem capable of communicating with one or more headends, wherein the television terminal receives television program signals based

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on the subscriber input; and  
a microprocessor connected between the interface and the modem,  
wherein the modem downloads data from the one or more headends to a local storage; and  
an output connected to the receiver and the modem, wherein the output accepts the television program signals from the receiver and data signals from the modem." (emphasis added).

In particular, the Banker reference discloses that the set top terminal may include a modem and telephone link to a telephone processor at the head end. (see Banker, Col. 4, Lines 40-50). It is noted that the Banker reference is completely silent with regard as to whether the modem is installed in the subscriber terminals as a hardware upgrade to the subscriber terminals.

Furthermore, the Palazzi reference fails to bridge a substantial gap as between the Banker reference and the Applicants' invention. Specifically, the Palazzi reference discloses "the terminal 17 also features an internal modem 4 so that the terminal 17 may communicate and transmit information to and from the host database via the subscriber's telephone line 1. The modem 4 may carry asynchronous or synchronous data from the subscriber's telephone line 1 and through the DAA, where it is then converted to digitally encoded information for use by the CPU5 (described below). Alternatively, the modem 4 will convert the digital information presented from the CPUS into low frequency analog signals for the DAA to transmit to the host database via the subscriber's telephone line 1" (see Palazzi, Col. 5, Line 63 to Col. 6, Line 6). Nowhere in the Palazzi reference is there any teaching or suggestion that the modem is installed into the subscriber's terminal as a hardware upgrade.

Even if the two references could somehow be operably combined, the combination would merely disclose a set top terminal having a modem not part of an upgrade of the set top terminal. Nowhere in the combined references is there any teaching or suggestion of "a hardware upgrade adding a data modulation and demodulation function to the television terminal comprising... a modem capable of communicating with one or more head ends, wherein the existing television terminal receives television program signals based on the subscriber input." That is, the combined references are completely silent in regard to providing or enabling a set top

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terminal to receive a hardware upgrade including a modem that is capable of communicating with one or more headends. Therefore, the combined references fail to teach or suggest the Applicants' invention as a whole.

Applicants would like to point out that the mere presence of a piece of hardware is not an upgrade. Hardware upgrade for the set top terminal is clearly defined by the specification. As described by the specification on page 24 lines 19-26:

The set top terminal 220 of the present invention may be achieved through a set of hardware upgrades to any of the following embodiments: (1) an existing set top converter 220 upgraded with a circuit card (which has a microprocessor electronically connected to the set top converter 220), such as a Turbo card 700 or the like; (2) an industry standard decompression converter 220 upgradeable by either an upgrade module or a menu generation card; and (3) a set top converter box 220 capable of both decompression and menu generation. The hardware upgrades provide additional advanced features and functional capabilities to any of these embodiments.

The claimed hardware upgrade allows for flexibility to set up STTs which quickly becomes obsolete. None of the references contemplates this issue. As such, Applicants submit that claims 30 and 42 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder.

Furthermore, the mere fact that a prior art structure, such as a system having a modem, could be modified to produce the claimed invention does not make the modification obvious unless the prior art suggested desirability of the modification. None of the cited references, either singly or in combination, teach or suggest "a hardware upgrade adding a data modulation and demodulation function to the television terminal comprising... a modem connected to the interface capable of communicating with one or more head ends, where the set top terminal receives television program signals based on the subscriber input." The advantage of an efficient terminal would not motivate an ordinary person skilled in the art at the time of the invention to combine these references in the specific manner as claimed. As stated above, the references as a whole must show a desirability of the combination; therefore, the combined references fail to teach or suggest the Applicants' invention as a whole.

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Moreover, none of the references address and solve the problems that the Applicants' invention solves. In particular, none of the references solve the problem of providing the flexibility to upgrade the set top terminals with a modem to provide data/fax/voice communications on an as-needed basis. Furthermore, the Applicants' invention solves the problem of set top terminals becoming quickly obsolete because they do not have the capability to be upgraded, as improvements in technologies allow for additional services to be provided to the subscriber of the set top terminals. Accordingly, the combined references fail to address the problems addressed and solved by the Applicants' invention.

Furthermore, claims 33-41, 45-50, 55, and 58-59 depend, either directly or indirectly, from independent claims 30 and 42, and recite additional features thereof. As such, and for at least the same reasons discussed above, Applicants submit that these dependent claims also fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, Applicants respectfully request that the rejections be withdrawn.

#### **Claims 43-44 and 57**

The Examiner has rejected claims 43-44 and 57 as being obvious under 35 U.S.C. §103 over Banker and Palazzi in further view of Vogel (U.S. patent no. 5,253,066, issued October 12, 1993). Applicants respectfully traverse the rejections.

#### **Claim 44**

Claim 44 was canceled in Applicants' response to the Preliminary Amendment filed on November 4, 2005. Therefore, the rejection regarding this claim is deemed moot.

#### **Claim 43 and 57**

Claims 43 and 57 respectively depend from independent claim 42 and recite additional features thereof. In particular, claims 43 and 57 recite in part:

"A method for delivering television programs through a television program delivery system with menu selection of programs, comprising:  
receiving a television program from one or more headends;

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receiving subscriber input through an interface within a set top terminal, the set top terminal having a microprocessor and microprocessor instructions for prompting generation of menus;

communicating through a modem with the one or more headends using a hardware upgrade inserted into the set top terminal, the hardware upgrade adding a data modulation and demodulation function to the set top terminal, and the communicating step comprising:

transmitting data based on the subscriber input;  
receiving data from the one or more headends; and  
downloading data from the one or more headends to a local storage using the hardware upgrade and the modem; and  
displaying the television program and/or information based on the received data." (emphasis added).

As discussed above, the Palazzi and Banker references merely disclose the set top terminal having a modem installed during original equipment manufacture. Nowhere do the combined references teach or suggest "communicating through a modem with the one or more headends using a hardware upgrade inserted into the set top terminal, the hardware upgrade adding a data modulation and demodulation function to the set top terminal."

Furthermore, the Vogel reference fails to bridge the substantial gap as between the Palazzi and Banker references, and the Applicants' invention. In particular, Vogel discloses "a signal representative of a television program guide, a signal indicating which program is currently being viewed or recorded and a signal indicating the class of program being viewed or recorded is received at the point of reception of a television program signal. The program guide signal is used to cause a program guide to be displayed on a television screen (see Vogel, Abstract)." Vogel does not teach, disclose or suggest "communicating through a modem with the one or more headends using a hardware upgrade inserted into the set top terminal, the hardware upgrade adding a data modulation and demodulation function to the set top terminal."

Even if the three references could somehow be operably combined, the combination would merely disclose a set top terminal having a modem installed during original equipment manufacture, and the set top terminal receiving a signal representative of a television program guide, a signal indicating which program is currently viewed, and a signal indicating the class of the program being viewed.

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Nowhere in the combined references is there any teaching or suggestion of "communicating through a modem with one or more head ends using a hardware upgrade inserted into the set top terminal, the hardware upgrade adding a data modulation and demodulation function to the set top terminal." Therefore the combined references fail to teach or suggest the Applicants' invention as a whole.

As such, Applicants submit that claims 43 and 57 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, Applicants respectfully request that the rejections be withdrawn.

#### Claims 52-54

The Examiner has rejected claims 52-54 under 35 U.S.C. §103(a) as being unpatentable over Banker and Palazzi in view of Sprague (U.S. Patent 5,247,575, hereinafter "Sprague"). Applicants respectfully traverse the Examiner's rejection.

For at least the reasons discussed above with respect to the Examiner's rejection of independent claim 42, claims 53-54 which depend from claim 42 are patentable over the Banker and Palazzi references singly or in combination. Sprague fails to bridge the substantial gap between the Banker and Palazzi references and Applicants' invention. In particular, Sprague merely discloses that CD-ROM can be used to archive information and can be connected to a system bus. There is no motivation or suggestion that a CD-ROM can be combined with a hardware upgrade. Moreover, Sprague is silent regarding "communicating through a modem with the one or more headends using a hardware upgrade inserted into the set top terminal, the hardware upgrade adding a data modulation and demodulation function to the television terminal."

Even if the three references could somehow be operably combined, the combination would merely disclose a set top terminal having a modem installed during original equipment manufacture, and the set top terminal receiving a signal representative of a television program guide, a signal indicating which program is currently viewed, and a CD-ROM. Nowhere in the combined references is there any teaching or suggestion of "communicating through a modem with one or more head ends using a hardware upgrade inserted into the existing set top terminal, the hardware

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upgrade adding a data modulation and demodulation function to the television terminal." Therefore the combined references fail to teach or suggest the Applicants' invention as a whole.

As such, Applicants submit that claims 52-54 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, Applicants respectfully request that the rejections be withdrawn.

#### **Claims 60, 63 and 64**

The Examiner has rejected claims 60, 63 and 64 as being obvious under 35 U.S.C. §103 over Granger in further view of Graczyk and Wachob (U.S. patent no. 5,231,494). Applicants respectfully traverse the rejections.

Applicants' independent claim 60 recites:

60. Apparatus for upgrading a capability of a set top terminal (STT), said STT having circuitry adapted to receive a data stream including a plurality of compressed television program signals, decompress a compressed program signal and provide a corresponding output signal adapted for use by a display device, said apparatus comprising:  
a STT interface, for enabling communication with said STT; and  
a modem for providing on-line communications with a content provider, said modem being a card insertable into said STT to add a data modulation and demodulation function to said STT. (emphasis added).

In particular, the Granger reference discloses "for subscribers who want to operate more than two simultaneous channels from among the six, the set-top can be designed in such a way that a switching module can be plugged into a slot at the rear of the set-top converter as shown in Fig. 6. There, a switching module 300 may be purchased separately and plugged into a standard set-top converter 302 having a block diagram as shown in Fig. 7. Also shown in Fig. 7 is a block diagram of the switching module 300 of Fig. 6." (see Granger, Col. 7, Lines 16-24, FIGs. 6 and 7). The switching module includes a splitter 330 and a tuner 332. Nowhere in the Granger reference is there any teaching or suggestion of hardware upgrade including a modem. Granger does not disclose, teach or suggest an insertable card including modem for upgrading an set top terminal.

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The Graczyk reference discloses a work station 10 formed by a host computer such as an IBM PC-AT compatible system having common communication circuitry within the work station 10 that includes data/fax/voice modem circuit 44, television circuit 46, AM/FM tuner circuit 48, and remote control circuit 50. The telecommunication circuitry 12 provides the user with the ability to send and receive computer data, facsimile transmissions and voice and audio sound over one or more conventional telephone lines. Host computer bus interface 300 provides a communications path between data/fax/voice modem 44 and host computer 24. Consequently, IBM PC-AT compatible industry standard architecture (ISA) interface specifications define the technical requirements for host computer bus interface 300. The data/fax/voice modem circuit 44 is configured to appear to the host computer as a communication circuit. Furthermore, Fig. 41 is just an expansion board containing data/fax/voice modem circuit. Accordingly, the Graczyk reference discloses a computer workstation that includes a conventional PC computer having a data/fax/voice modem circuit disposed therein. (see Graczyk, Col. 5, lines 15-25, lines 38-51, lines 62-67, Col. 6 lines 33-48, and lines 62-Col. 7, Line 18, and FIGs. 1 and 2). Graczyk does not disclose, teach or suggest upgrading using an insertable card including a modem for upgrading a STT.

The Wachob reference discloses that a set top terminal may include a demodulator for demodulating TV programming. (see Wachob, Col. 6, Lines 7-24). It is noted that the Wachob reference is completely silent with regard to whether the modem is installed in the subscriber terminals as a hardware upgrade to the subscriber terminals. Wachob does not disclose, teach or suggest upgrading a set top terminal with an insertable card including a modem.

According to MPEP 2143, "teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "The Examiner has improperly combined the teachings of the Granger with the two other cited references. Specifically, there is no disclosure, teaching or suggestion of an insertable card including a modem for upgrading a set top terminal. Therefore, the combined references fail to teach or suggest the Applicants' invention as a whole.

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Furthermore, the mere fact that a prior art structure, such as a set top box, could be modified to produce the claimed invention does not make the modification obvious unless the prior art suggested desirability of the modification. None of the cited references, either singly or in combination, teach or suggest a hardware upgrade comprising a modem capable of providing on-line communication. The references as a whole must show a desirability of the combination; therefore, the combined references fail to teach or suggest the Applicants' invention as a whole.

Moreover, none of the references address and solve the problems that the Applicants' invention solves. In particular, none of the references solve the problem of providing the flexibility to upgrade the STT with a modem to provide data/fax/voice communications on an as-needed basis. Furthermore, the Applicants' invention solves the problem of set top terminals becoming quickly obsolete because they do not have the capability to be upgraded, as improvements in technologies allow for additional services to be provided to the subscriber of the set top terminals. Accordingly, the combined references fail to address the problems addressed and solved by the Applicants' invention.

In addition, an upgrade is not any improvement over any previous devices. An upgrade involves additional features and/or reprogramming of existing features of the set top terminal. Therefore, Granger and the other two cited references do not teach, suggest or disclose hardware upgrading with a modem in the set top terminals. Therefore, the combined references fail to teach or suggest the Applicants' invention as a whole.

Furthermore, claims 63 and 64 depend, either directly or indirectly, from independent claim 60, and recite additional features thereof. As such, and for at least the same reasons discussed above, Applicants submit that these dependent claims also fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, Applicants respectfully request that the rejections be withdrawn.

#### **Claims 61 and 62**

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The Examiner has rejected claims 61 and 62 under 35 U.S.C. §103(a) as being unpatentable over Granger, Graczyk and Wachobe in view of Pond (U.S. Patent 5,329,590). Applicants respectfully traverse the Examiner's rejection.

For at least the reasons discussed above with respect to the Examiner's rejection of independent claim 60, claims 61-62 which depend from claim 60 are patentable over the Granger, Graczyk and Wachobe references singly or in combination. Pond fails to bridge the substantial gap between the Granger, Graczyk and Wachobe references and Applicants' invention. In particular, Pond merely discloses that a satellite receiver/descrambler initiates from time to time a billing and usage history transfer to the service provider by accessing the telephone modem. There is no motivation or suggestion that this method can be combined with the hardware upgrade. Moreover, Pond is silent on an insertable card including a modem for upgrading a set top terminal.

Even if the four references could somehow be operably combined, the combination would not teach or suggest "a modem for providing on-line communications with a content provider, said modem being a card insertable into said STT to add a data modulation and demodulation function to said STT." Therefore the combined references fail to teach or suggest the Applicants' invention as a whole.

As such, Applicants submit that claims 61 and 62 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, Applicants respectfully request that the rejections be withdrawn.

#### **Claim 65**

Claim 65 is not rejected in the Detailed Action, but is rejected according to the Office Action Summary. Applicant would like the Examiner to explicitly state the rejection for claim 65. If no rejection is explicitly stated, Applicants respectfully request that the rejection be withdrawn.

#### **SECONDARY REFERENCES**

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to Applicants' disclosure than the

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primary references cited in the Office Action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

### **CONCLUSION**

Applicants believe all the claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring the issuance of an adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

7/25/05

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IN THE UNITED STATES  
PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

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JUL 25 2005

Applicant(s): John S. Hendricks et al.  
Serial No.: 09/396,429  
Examiner: Andrew Y. Koenig  
Filed: 9/15/99 Group Art Unit: 2611  
Confirmation #: 7434 Case: 5815 (SEDN/5815)  
Title: TELEVISION TERMINAL MODEM

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Under separate cover, Applicants have filed a POWER OF ATTORNEY/  
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attached for the convenience of the office.

Applicants respectfully request a corrected filing receipt. A marked copy of the  
October 6, 1999 filing receipt is also attached. The continuing data as claimed by  
Applicant should read as follows:

THIS APPLN IS A DIV OF 07/991,074 12/09/92  
AND A DIV OF 08/160,194 12/2/93  
WHICH IS A CIP OF 07/991,074 12/09/92

SN 09/396,429

Page 2 of 2

Respectfully submitted,

20/05/07

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FILING RECEIPT



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APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTORNEY DOCKET NO.	DRWGS	TOT CL	IND CL
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Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts of Application" ("Missing Parts Notice") in this application, please submit any corrections to this Filing Receipt with your reply to the "Missing Parts Notice." When the PTO processes the reply to the "Missing Parts Notice," the PTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

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CONTINUING DATA AS CLAIMED BY APPLICANT-

THIS APPLN IS A DIV OF 07/991,074 12/09/92 08/160,194 12/21/99  
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